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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,807	02/20/2004	Peter Sils	12079-0002	3949
22902	7590	03/22/2006	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			AGARWAL, MANUJ	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,807

Applicant(s)

SILS, PETER

Examiner

Manuj Agarwal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-28-04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/458,041, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. A diameter range of 45 to 60 millimeters, rather than a range of 45-70 millimeters is disclosed. Furthermore, the use of the ball in a vehicle is not disclosed as well. Claims 1,10 and 11 therefore do not have the effective filing date of this provisional application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15 are rejected under 35 U.S.C. 102(a,b) as being anticipated by Huizhgu Hui Lon Plastic Pty.

The disclosure of this application states that the claimed balls are obtained from an outside manufacturer, namely Huizhgu Hui Lon Plastic Pty., or an outside distributor Flow Tack Co. Ltd. This implies that the balls are not part of the inventive concept of this application for they are already known and available for public use prior to the submission of this invention. The apparatus claims drawn to the structure of the gel ball would be anticipated by Huizhgu Hui Lon Plastic Pty. The ball obtained from these two sources has the claimed size, density and material of composition.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittler (2005/0283100) in view of Huizhgu Hui Lon Plastic Pty.

Whittler discloses a method of using a round gel massage ball to press on points and/or muscles in the back or other part of a user.

Regarding claims 1-5, Whittler's ball is said to range in size from a diameter of 0.25 to 6 inches (paragraph 22), or 6 to 152 millimeters. This range encompasses 45-

70,50-60 and 54-55 millimeters. Whittler lacks a massage ball of the claimed density and material of composition. It would have been obvious to utilize the ball of Huizhgu Hui Lon Plastic Pty because it is publicly available for use and sale and is thus easily accessible.

Regarding claims 6 and 7, Whittler teaches that his ball is placed between the user and a horizontal surface and the user presses the back into the ball. The rotational manipulation is "self-directed" by the user (paragraph 19). The user can control his/her movement and may simply press the ball into their back. Furthermore, when the ball is first applied between the user's back and the floor, the user will lay on the ball and put his/her body weight onto the ball before moving around. Thus the user presses their back into the ball while it is held stationary.

Claims 1,8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (US 2,466,470) in view of Huizhgu Hui Lon Plastic Pty.

Norris discloses a massage ball and its method of use.

Regarding claim 1, Norris lacks the claimed size, density and material of composition. It would have been obvious to use the ball of Huizhgu Hui Lon Plastic Pty.

Regarding claims 8,9, Norris teaches that his ball is secured to a wall—an inanimate holder (col. 2 lines 5-7). Fig. 1 shows a user pressing their body into the massage ball while it is held stationary. Col. 2 lines 35-39 states that the user moves so that other areas of their body are contacted during the pressing step.

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Regarding claim 10, Norris teaches the pressing of a user's body into a massaging ball against a vertical surface. It would have been obvious to place the ball against a surface inside a vehicle for the delivery of therapy during transportation.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US 2005/0015032. Stein. Massage Ball and Method of Use.
2. US 2005/0015025. Stein. Massage Ball and Method of Use.
3. US 754,925. Adusht-Hanish. Massaging Device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuj Agarwal whose telephone number is (571) 272-4368. The examiner can normally be reached on Mon to Fri 9:00 AM 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571)272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuj Agarwal  
Patent Examiner

MA



**Danton D. DeMille**  
**Primary Examiner**